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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,803	08/24/2001	Henry Yue	PF-0695-2 CON	3863
27904	7590	10/01/2003		
INCYTE CORPORATION (formerly known as Incyte Genomics, Inc.) 3160 PORTER DRIVE PALO ALTO, CA 94304				EXAMINER CHUNDURU, SURYAPRABHA
				ART UNIT 1637 PAPER NUMBER

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/938,803	YUE ET AL.	
	<b>Examiner</b> Suryaprabha Chunduru	<b>Art Unit</b> 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 24 August 2001.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-16, 18, 21, 24, 26-27 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 1-16, 18, 21, 24, 26-27 are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6) Other: \_\_\_\_\_

**Election/Restrictions**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, 9, 15-16 drawn to a purified polypeptide, and a composition, requiring SEQ ID NOS. 1-20, classified in class 530, subclass 300.
- II. Claims 3-7, 10-11, drawn to isolated nucleic acid, vector, host cells, all requiring SEQ ID NOS. 1-40, classified in class 536, subclass 23.1, class 435, subclass 320.1.
- III. Claim(s) 8, drawn to a transgenic organism, requiring SEQ ID NOS. 1-20, classified in class 800, subclass 295.
- IV. Claims 12-14, drawn to a method for detection of a target polynucleotide in a sample, requiring SEQ ID NOS. 21-40, classified in class 435, subclass 6.
- V. Claims 18, 21, 24, are drawn to methods for screening a compound for effectiveness as an agonist of a polypeptide requiring SEQ ID NOS. 1-20, classified in class 435, subclass 7.1.
- VI. Claims 26-27, are drawn to methods for screening a compound for effectiveness in altering expression of a target polynucleotide, requiring SEQ ID Nos. 21-40, classified in class 435, subclass 69.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case Group I is independent and distinct from the method as claimed in Group V

because all the products in Group I can be used in a materially different processes such as in blotting assays and immunological assays.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case Group II is independent and distinct from the method as claimed in Group IV because all the products in Group II can be used in a materially different processes such as in purification assays or gene therapy assays.

Inventions II and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case Group II is independent and distinct from the method as claimed in Group VI because all the products in Group II can be used in a materially different processes such as in purification assays or gene therapy assays.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions. In the instant case the polypeptides of Group I and the nucleic acids of Group II can be used independent of each other with different end results.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions. In the instant case the product of Group II can be used independent of Group III with different end results.

Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions. In the instant case the method of Group V and Group VI can be used independent of each other, because each have a different mode of operation and a different effect.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search for one group is not required for any other group, restriction for examination purposes as indicated is proper.

Additionally, each group named above is subject to further restriction. Applicant is required to elect a specific SEQ ID NO. for examination. This requirement is made under 1192 O.G. 68 Notice (November 19, 1996 and revised M.P.E.P.), as the examination of more than one sequence in the application would result in an undue search burden on the PTO. Further, this is NOT an election of species. Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequences are presumed to represent an

independent and distinct invention, subject to restriction requirement pursuant to 35 USC 121 and 37 CFR 1.141. By statute, “[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.” 35 U.S.C. 121. Pursuant to this statute, the rules provide that “[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant... to elect that invention to which his claim shall be restricted.” 37 CFR 1.142 (a). See also 37 CFR 1.141(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and - for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Suryaprabha Chunduru  
September 26, 2003

JEHANNE SOUAYA  
PATENT EXAMINER  
Primary  
*Jehanne Souaya*  
9/29/03